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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,489	03/20/2007	Kamaluddin Abdur-Rashid	14696-13	7292
1059 7590 05/30/2008 BERESKIN AND PARR 40 KING STREET WEST BOX 401 TORONTO, ON M5H 3Y2 CANADA				
EXAMINER NWAONICHA, CHUKWUMA O				
ART UNIT		PAPER NUMBER		
1621				
MAIL DATE		DELIVERY MODE		
05/30/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/596,489

Applicant(s)

ABDUR-RASHID, KAMALUDDIN

Examiner

CHUKWUMA O. NWAONICHA

Art Unit

1621

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 5-19 and 25-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5-19 and 25-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Current Status

1. This action is responsive to Applicants' amendment of 22 February 2008.
2. Receipt and entry of Applicants' amendment is acknowledged.
3. Claims 1, 3, 5-19 and 25-53 are pending in the application.
4. The 102 rejection of claim 1 as being anticipated by Cobley et al. is withdrawn in because the prior art does not teach all the claim limitations.
5. The 102 rejection of claim 1 as being anticipated by Tararov et al. is withdrawn in because the prior art does not teach all the claim limitations.
6. The 103 rejection of claims 1-4 is withdrawn in favor of a new rejection.
7. The obviousness-type double patenting rejection is withdrawn following Applicants amendments.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 3, 5-19 and 25-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cobley et al., {US 6,528,687, same as WO 2002008169}.

Applicants claim a method for producing an amine from an imine in the presence of a base, a ruthenium complex comprising: a diamine, diphosphine ligand or monodentate diphosphine ligand; wherein all the other variables are as defined in the claims.

Determination of the scope and content of the prior art (M.P.E.P. §2141.01)

Cobley et al. teach a process of making an amine from an imine in the presence of a base, a ruthenium complex of a chiral diphosphine and a chiral diamine. Cobley et al. teach a process wherein the substituent (R^3 in formula 10 or 11) on the nitrogen is non-interfering organic group, and the Examiner has interpreted this group to be hydrogen substituted C-C double bond or C-C triple bond. The reaction was conducted in an organic solvent. See the abstract, columns 1-8 and the examples.

Ascertainment of the difference between the prior art and the claims (M.P.E.P. §2141.02)

Cobley et al. process for preparing an amine from an imine differs from the instantly claimed process in that applicants' claimed process wherein the three substituents (R^2 , R^2 and R^3) on the nitrogen is in formulas I and II are broader in scope than the three substituents (R^2 , R^2 and R^3) on the nitrogen is in formulas I and II of Cobley et al. Another difference between Applicant claimed invention and the teaching

of Cobley et al. is that Applicants claim a base such as DBU, NR_3 and phosphazene while Cobley et al. teach base in general including t-BuOK.

Finding of prima facie obviousness--rational and motivation (M.P.E.P.. §2142-2143)

The instantly claimed process for preparing an amine from an imine would have been suggested to one of ordinary skill because one of ordinary skill wishing to obtain an amine from imine is taught to employ the process of Cobley et al.

One of ordinary skill in the art would have a reasonable expectation of success in practicing the instant invention by following teaching and the examples of reference cited to arrive at the instantly claimed process for preparing an amine. Said person would have been motivated to practice the teaching of the references cited because it demonstrates that amines are useful industrial chemicals. The Examiner notes that varying the substituents on the starting material, reactants or the additives in a chemical reaction is a well-known chemical practice to optimize the process efficiency of the system and does not constitute a patentable distinction. Moreover, all the claimed elements (H_2 , a base, a catalyst system, a diphosphine ligand or monodentate phosphine ligand) were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in art at the time of the invention. Therefore, the instantly claimed **process** would therefore have been obvious to one of ordinary skill in the art.

Applicants' amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chukwuma O. Nwaonicha whose telephone number is 571-272-2908. The examiner can normally be reached on Monday thru Friday, 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne (Bonnie) Eyster can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Art Unit: 1621

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Chukwuma O. Nwaonicha/
Examiner, Art Unit 1621

/Jafar Parsa/
Primary Examiner, Art Unit 1621